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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/692,716 10/20/00 DECOSTER S 05725.0782.0

EXAMINER

HM22/0509

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ART UNIT	PAPER NUMBER
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1619

DATE MAILED:

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/692,716	DECOSTER ET AL.
	Examiner Gina C Yu	Art Unit 1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 28 February 2001 .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-104 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-104 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)  
17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 20)  Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

(A) The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-104 are rejected under 35 U.S.C. § 112, first paragraph, because the claims are broader than the enabling disclosure.

Regarding claims 1, 92, 101, 102, and 104, the specification enables for the specific functional groups that can be encompassed by  $R_2$  in formula (I), whereas the scope of the claim encompasses other types of functional groups. See claim 1, lines 9-11. The disclosure is limited to only those functional groups listed in p. 5, lines 1-9 of the specification. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

(B) The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-104 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, 92, 101, 102, and 104 are rejected because the metes and bounds of “group that can react by chain addition reaction” and the term “can optionally further comprise” are unclear, rendering the claims vague and indefinite.

Claim 14 is rejected because the term “essentially” is relative or subjective, rendering the claim vague and indefinite.

Claim 97 is rejected because the term “satisfactory” is relative or subjective, rendering the claim vague and indefinite.

Claim 101 is rejected because the term “caring” is vague and indefinite because the metes and bounds of the patent protection sought are unclear.

The depending claims of the above mentioned claims are also rejected.

Claim 39 is objected because of the typographical error in line12, “wherein in”.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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(A) Claims 1-18, 21, and 101-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. (EP 0874017) taken with Zviak (The Science of Hair Care, p. 68-70).

Dalle et al. teach a method of making silicone in water emulsions for cosmetic products, comprising at least one polysiloxane identical to formula (I) in claim 1 and at least one surfactant among anionic, nonionic, amphoteric, and cationic surfactants. The particle size of the silicone copolymer is also in the range of 0.3 – 100  $\mu\text{m}$ , which meets claims 11-12. See p. 5, lines 35-41. In the reference, 9 parts by weight of polysiloxane is used, which meets claims 13, 15, 16 in the instant application. See Examples 1-3 on p. 6. Although the reference suggests adding conventional ingredients including suspending agents and polymers in the composition, the reference lacks a specific mention of using non-cellulose thickener. See p. 6, lines 1-4.

Zviak teaches thickeners for shampoo formulations. See p. 69. The thickeners listed in the reference include natural gums, including karaya, and carboxyvinyl polymers of the Carbopol type, thereby meeting claims 17, 18, and 21.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition in Dalle et al. by adding conventional non-cellulose thickeners in Zviak because of the expectation to have produced hair care compositions with desired viscosity.

(B) Claims 1-17, 19, 20, 22, 24, and 101-104 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dalle et al. in view of Quack et al. (U.S. Pat. No. 4,237,243).

Dalle et al. is discussed above. The reference lacks the teaching of using non-cellulose thickening agents in the composition.

Quack et al. teaches the use of crosslinked polymers for increasing the viscosity in cosmetic compositions. The reference teaches the use of the water-soluble copolymers of acrylamide or acrylic acids, which meets claim 17, 19, and 20. See col. 3, line 8 – col. 4, line 27. For claim 22, see col. 4, lines 5 – 19. The use of thickeners in natural origin is also disclosed in col. 1, line 40, which meets claim 18. Claim 24 is met by the disclosure which illustrates formulations for cleansing liquid solutions comprising polyethylene glycols. See Examples in col. 14, lines 21 – 31; col. 15, lines 2 – 12. The reference teaches that the polymers in that invention have high swelling power which is particularly appropriate as a thickening agent in cosmetic compositions. See col. 7, lines 27 – 47.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition in Dalle et al. by adding the thickeners disclosed in Quack et al. because of the expectation to have produced cosmetic compositions with desired viscosity.

(C) Claims 1-19, 22, 23, 25-36, and 101-104 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dalle et al. in view of Mougin et al. (U.S. Pat. No. 6,166,093).

Dalle et al. is discussed above. The reference lacks the teaching of using non-cellulose thickening agents in the composition.

Mougin et al. describe cosmetic compositions comprising silicone-grated polyurethane and/or polyurea block polycondensation products. See col. 1, lines 8 – col. 2, line 55; col. 14, line 63 – col. 15, line 27. The reference teaches that the composition may additionally comprise conventional thickeners, including;

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- (1) guar gum and xanthan gum, which meets claims 17-18;
- (1) "Bozepol C", the crosslinked acrylamide and ammonium acrylate polymers, which meets claims 19, 22, 23 and 25-28;
- (2) "Sepigel 305", the crosslinked acrylamide and 2-acrylamido-2-methylpropanesulphonic acid polymers, partially or totally neutralized, which meets claims 19, 22, 23 and 29-31;
- (3) "Salcare SC95", the crosslinked acrylamide and methacryloyloxyethyltrimethylammonium chloride polymers which meets, claims 19, 22, 23, 32, and 33;
- (4) the crosslinked homopolymers of methacryloyloxyethyltrimethylammonium chloride, which meets claim 19, 22, and 23.

See col. 15, line 39 – col. 16, line 35. Example 10 illustrates a formulation for mascaras which employs 2 % by weight of gum arabic, which is considered to be a natural thickener and meets claims 34-37.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions in Dalle et al. by adding the conventional thickening agent taught by Mougin et al. because of the expectation to have produced cosmetic compositions with desired viscosity.

(D) Claims 38-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al., and Mougin et al. as applied to claims 1-19, 22, 23, 25-36, and 101-104 above, and further in view of Restle et al. (U.S. Pat. No. 6,039,936).

Dalle et al. and Mougin et al. are discussed above. The combined references lack a mention that the specific surfactants in claims 37 - 63 may be used in the composition.

Restle et al. teach cosmetic oil-in-water emulsions comprising nonionic amphiphilic lipids (silicone surfactants) and cationic amphiphilic lipids. The patent describes the cationic amphiphilic lipids from the group formed by quaternary ammonium salts that meet claims 37 - 60. See col. 3, line 4 – col. 6, line 12. Examples 1 and 2 in the references also teach employing 1.5 % of the disclosed cationic amphiphilic lipids, which meets claims 61-63. The reference further teaches that the advantages of the compositions include an enhanced penetration of active cosmetic ingredients on hair, and glossy appearance without greasy feel and softness. See col. 1, lines 36-49.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the compositions in the combined references by adding the cationic surfactants of the quaternary ammonium salts in Restle et al. because of the expectation to have produced compositions which would enhance penetration of actives and glossy appearance, and softness on hair, as taught by Restle et al.

(E) Claims 64-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. and Mougin et al. as applied to claims 1-19, 22, 23, 25-36, and 101-104 above, and further in view of Decoster et al. (U.S. Pat. No. 6,150,311).

Dalle et al. and Mougin et al. are discussed above. The combined references lack a mention that the specific surfactants in claims 64-89 may be used in the composition.

Decoster et al. describe cosmetic compositions for cleansing and conditioning keratinous materials. The compositions in the reference comprise of insoluble silicone and a washing base, which is a mixture of anionic, amphoteric, nonionic and cationic surfactants. The reference teaches that the compositions comprise 4-50% by weight of the washing base, which meets claims 64-67. See col. 1, line 1 – col. 2, line 28. The anionic surfactants in claims 68-75 are disclosed in col. 2, lines 32 – 67; the nonionic surfactants in claims 76-79, in col. 3, lines 1-31; the amphoteric surfactants in claims 80-84, in col. 3, line 32 - col. 4, line 13. The reference further teaches that the most preferred mixture of the surfactants comprise anionic and amphoteric surfactant, of which the examples are disclosed in col. 4, lines 14-38. Accordingly, claims 85-89 are rejected. The reference further teaches that 0.001 – 10% by weight of cationic polymers may be employed in the composition, which meets claims 90 and 91. See col. 7, line 9 – col. 8, line 9. The method of using the compositions, which meets claims 92-104, are disclosed in col. 8, lines 20- 44. The reference teaches that a stable detergent composition having excellent cosmetic properties may be formulated from insoluble silicones in the washing base described above. See col. 1, line 55 – col. 2, line 5. The reference further teaches optional use of cationic surfactants, including quaternary ammonium salts and imidazoline derivatives.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions in the combined references by adding the surfactants disclosed in Decoster et al., because of the expectation to have produced stable cleansing compositions for kerataneous materials which retain the advantages of cosmetic properties of the actives, as taught by Decoster et al.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-104 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-84 of copending Application No. 09/692360 in view of Zviak, Quack et al. and Mougin et al.

The instant claims 1-17 and 38 – 104 are substantial duplicate claims of 1-84 of the copending application, which is directed toward a cosmetic composition comprising an aqueous emulsion containing silicone copolymer of formula (I) and cationic surfactants of formula (IV),

(V), (VI), (VII) with identical limitations. The copending application does not claim non-cellulose thickeners, which are claimed in claims 18-37 in the instant application.

Zviak, Quack et al., and Mougin et al. are discussed above.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have varied the composition claimed in the copending application by adding the thickening agents well known in the art because of the expectation to have produced cosmetic compositions with desired viscosity, as taught by Zviak, Quack et al., and Mougin et al.

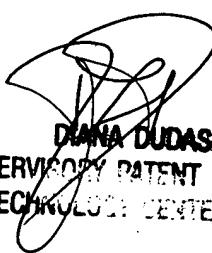
This is a provisional obviousness-type double patenting rejection.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
May 7, 2001

  
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